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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/649,973

Applicant(s): Vogl et al.

Filed: August 29, 2000

Art Unit: 2155

Examiner: Bharat Barot

Title: A Method of Doing Business Over a Network by Transmission and Retransmission of Digital Information on a Network During Time Slots

Attorney Docket No.: YOR920000532US1

Customer No.: 29,683

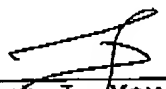
Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Transmittal of Petition To Commissioner

Sir:

The attached Petition to Commissioner was previously submitted for filing on August 9, 2005 with an incorrect serial number. Please reconsider the Petition to Commissioner submitted herewith for filing with the correct serial number 09/649,973. The Commissioner is authorized to charge any fee required or fee deficiency as a result of resubmitting this Petition to Commisioner to deposit account 50-1924.

Respectfully submitted,



11/21/05
Date

Robert J. Mauri (Reg. No. 41,180)
Customer No.: 29683
Harrington & Smith, LLP
4 Research Drive
Shelton, CT 06484-6212
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CERTIFICATION OF FACSIMILE TRANSMISSION

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Received Cover Page ========>

AUG. 9. 2005 2:29PM HARRINGTON & SMITH NO. 705 P.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/649,973

Applicant(s): Vogl et al.

Filed: August 29, 2000

Art Unit: 2155

Examiner: Bharat Barot

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Attorney Docket No.: YOR920000532US1

Customer No.: 29,683

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Transmittal of Petition To Commissioner(37 C.F.R. 61.181)

Sir:

The present Petition is filed well before the shortened statutory period of September 28, 2005. Applicants respectfully request resolution, if possible, of the present Petition prior to September 28, 2005.

1

PAGE 1/7 * RCVD AT 8/9/2005 3:26:01 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/28 * DNIS:2738300 * CSID:2039440245 * DURATION (mm-ss):02-00

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Application No.: 10/649,973

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Attorney Docket No.: YOR920000532US1

Customer No.: 29,683

Mail Stop Petition
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Transmittal of Petition To Commissioner(37 C.F.R. §1.181)

Sir:

The present Petition is filed well before the shortened statutory period of September 28, 2005. Applicants respectfully request resolution, if possible, of the present Petition prior to September 28, 2005.

Respectfully submitted,

Robert J. Mauri (Reg. No. 41,180) — 9 Aug 2005 Date

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4 Research Drive
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203-925-9400

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Ann Okrentowich
Ann Okrentowich

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Atty. Docket:

Vogl *et al.* YOR920000532US1

Serial No.: 09/649,973 Group Art Unit: 2155

Filed: August 29, 2000 Examiner: Bharat Barot

Title: A Method of Doing Business Over a Network by Transmission and Retransmission of Digital Information on a Network During Time Slots

PETITION TO COMMISSIONER UNDER 37 C.F.R. §1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner.

Statement of Facts

The present application was filed on August 29, 2000, with claims 1-19, of which claim 1 is the sole independent claim in claims 1-19.

On December 2, 2004, Applicants responded to an Office Action mailed on September 17, 2004.

On April 15, 2005, Applicants filed a Supplemental Amendment, adding claims 20-22, of which claim 20 is the sole independent claim in claims 20-22.

In a final rejection dated June 28, 2005, the Examiner withdrew claims 20-22 as being restricted. The Examiner restricted the claims into Invention (I), claims 1-19, and Invention (II), claims 20-22.

In a Response filed on July 19, 2005, Applicants' Attorney requested reconsideration of the claim restriction.

In an Advisory Action mailed July 28, 2005, the Examiner upheld the restriction and made the restriction FINAL.

Point to be Reviewed

Is the restriction of the claims 1-19 and 20-22 into two different groups, Inventions (I) and (II), of claims proper?

Action Requested

The Assistant Commissioner for Patents is requested to reverse the Restriction Requirement regarding the restriction of the claims in Inventions (I) and (II) and direct the Examiner to examine claims 1-19 and 20-22.

Discussion

In the restriction requirement, the Examiner asserted the following:

> Inventions (I) and (II) re related as subcombinations disclosed as useable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately useable (MPEP §806.05(d)).
>
> In the instant case, Invention (I) has separate utility such as predicting transmission time based on a number of packet (size) and a network speed; and invention (II) has separate utility such as predicting transmission time, priority, and cost based on a size and a network capacity; and transmitting digital information based on the time, a source address, and an identification of a recipient and also has utility by itself or in other combinations (MPEP §806.05(c)).

Office Action of June 28, 2005, section 2. Firstly, the Examiner has not cited any part of the present application that shows where Inventions (I) and (II) are shown as "subcombinations ***disclosed*** as useable together in a single combination" as recited in

MPEP §806.05(d)[1] (emphasis added). While the Examiner argues that independent claims 1 and 20 have separate utility, one could argue, as described below in more detail, that independent claim 20 is a narrower version of independent claim 1. Furthermore, MPEP §806.03 states the following:

> Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should **never** be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

MPEP §806.03 (Aug 2001) (bold emphasis added). Thus, regardless of whether or not the claims might be classified in different classes and subclasses, restriction should not be required where the claims define the same essential characteristics of a *single* disclosed embodiment.

Claims 1 and 20 all relate to the **single embodiment** shown in FIG. 8. It should be noted that portions of FIG. 8 are described in other figures. For instance, the request block 700 of FIG. 8 is shown in FIG. 7; the estimate transmission block 1000 is shown in FIG. 10; and the schedule dispatch block 1100 is shown in FIG. 11. Nonetheless, both independent claims 1 and 20 are related to FIG. 8. Thus, regardless of whether or not the claims might be classified in different subclasses, and regardless of the burdensomeness of the search required by the Examiner, restriction should not be required where the claims define the same essential characteristics of a *single* disclosed embodiment.

Moreover, it is unlikely that any extra burden would be imposed on the Examiner in order to examine both Inventions (I) and (II). Both independent claims 1 and 20 are directed to a method of doing business over a network, receiving requests for transmitting digital information, determining times required to transmit the digital information, and determining based on certain criteria whether the digital information can

[1] MPEP §806.05(d) (Aug 2001) states the following: "Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other."

be accepted for transmission or transmitted based on certain criteria. There should be little or no extra burden on the Examiner to examine both claims 1 and 20 of Inventions (I) and (II), respectively. Additionally, although independent claim 20 of Invention (II) is related to the subject matter of cost (e.g., for transmission), dependent claims 2, 4, and 5 of Invention (I) also are related to price for transmission. Therefore, there appears to be few or no justifiable reasons to restrict out claims 2, 4, and 5 from claim 20 because these claims recite similar subject matter.

According to the Examiner, Invention (I) is classified in class 709, subclasses 223-224 and 227-228, while Invention (II) is classified in class 709, subclasses 206-207 and 245-246. Firstly, this classification is unclear, as subclasses 206 and 207 are related to "Computer conferencing" (the main heading under which subclasses 206 and 207 are assigned). Computer conferencing appears to be unrelated to the subject matter of the disclosed invention as embodied in independent claim 20, as claim 20 is directed to transmitting data to a recipient when certain conditions are met, but the entities transmitting and receiving data typically are not in a "conference". Furthermore, subclass 246 is related to "Computer-to-computer data modifying", which does not appear to be related to the subject matter of the disclosed invention as embodied in independent claim 20, as a single entity typically makes decisions about whether data should be transmitted or not.

Secondly, even if the classification is correct, subclass 206 relates to "Priority based messaging". Dependent claim 12 of Invention (I) recites "where the request has one or more priorities", which means that the Examiner likely will have to examine class 709, subclass 206 anyway in order to properly examine claim 12. This means that at least one of the subclasses for Invention (II) will already be examined during examination for Invention (I).

Claims 1 and 20 vary in scope, but they all relate to the single embodiment shown in FIG. 8. Thus, claims 1 and 20 are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition. Moreover, there

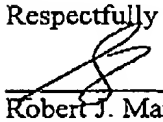
should be little if any additional burden on the Examiner to search for both Inventions (I) and (II). The Examiner should be ordered to examine both Inventions (I) and (II).

Summary

A requirement for two separate patents does not appear to be appropriate in view of the subject matter of the claims in Inventions (I) and (II). The claims of Inventions (I) and (II) (claims 1-19 and claims 20-22, respectively) all appear to define the same essential features as specified in MPEP §806.03. The Examiner has not properly shown that the provisions of MPEP §806.05(a)-(i) appear to apply to the claims of Inventions (I) and (II). Even if the provisions of MPEP §806.05(a)-(i) were shown to apply to the claims of Inventions (I) and (II), because of MPEP §806.03 restriction still would not be proper in this case. Therefore, the Assistant Commissioner For Patents is requested to reverse the Examiner's restriction regarding the claims of Inventions (I) and (II), and to direct the examiner to examine all the claims in these groups (i.e., claims 1-19 and 20-22).

It should be noted that the previous arguments are not directed to novelty of one Invention as compared to the other Invention; instead, the Applicants are simply arguing that Inventions (I) and (II) should be examined together.

Respectfully submitted,



9 Aug 2005

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Ann Okrentowich

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